

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the specification and claims and the following remarks.

Status of the Claims

In the present Amendment, claims 1, 3 and 7 have been amended, claims 2, 4, 5 and 8 have been canceled without prejudice or disclaimer of the subject matter contained therein, and claims 9-11 have been added. Thus, claims 1, 3, 6, 7 and 9-11 are pending in the present application.

No new matter has been added by way of these amendments and new claims. The amendment to claim 1 incorporates the subject matter from canceled claim 5. Also, the amendment to claim 1 is supported in the specification at page 4, line 6. The amendments to claims 3 and 7 are obviously clarifying in nature and not narrowing in scope. By deleting/amending these terms in order to clarify the claimed invention (e.g., "wt%" to "percent by weight"), Applicants are in no way conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents. New claim 9 has support in Examples 1-18. Support for new claim 10 is found at page 3, lines 9-13. Finally, new claim 11 has support at page 3, lines 16-18.

The abstract has been amended to be one paragraph. No new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the objection and rejections and allow the currently pending claims.

Claim Objection

The Examiner has objected to claims 3 and 8 for reciting “wt%.” The Examiner suggests replacing the disputed claim language with “percent by weight.”

First, Applicants respectfully point out that claim 8 has been canceled, thereby rendering the objection of this claim moot. Second, regarding claim 3, the issue has been addressed since the Examiner’s suggestion has been adopted. Thus, withdrawal of this objection is respectfully requested.

Issues under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claim 7 under 35 U.S.C. § 112, second paragraph, for reciting the phrase “Japanese sweets.” Applicants respectfully traverse and respectfully refer the Examiner to the present specification starting at page 4, line 17, which gives sufficient and ample examples of Japanese sweets. Regarding the comments in the Office Action, Applicants note that undue breadth of claims is not indefiniteness, and that claim language must be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Johnson and Farnham*, 194 USPQ 187, 194 (CCPA 1977). As pointed out above, those skilled in the art will be able to determine immediately from Applicants’ detailed specification what is a Japanese sweet. Thus, Applicants respectfully submit that the disputed subject matter embraced by claim

7 is definite and fully complies with 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of this rejection is respectfully requested.

Issues under 35 U.S.C. § 102(b)

Claims 1-2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,587,119 (hereinafter "**Bucke *et al.* '119**") (see pages 2-4 of the Office Action). Applicants respectfully traverse and reconsideration is based on the following remarks.

In the Office Action at page 3, second paragraph, the Examiner states that "isomaltulose" is a sugar alcohol. Applicants respectfully disagree. Isomaltulose is a sugar obtained by having a transfer enzyme acting on saccharose, and thus isomaltulose not a sugar alcohol.

The food as recited in instantly pending claim 1 comprises a sweetner mixture comprising a maltitol and cane sugar, wherein the mixing ratio (weight ratio) of the maltitol to cane sugar is 15:85 to 60:40. The cited Bruke *et al.* '119 reference fails to disclose all instantly claimed features, including the claimed maltitol and mixing ratio. In this regard, anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949 (Fed. Cir. 1990) (citing *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Bruke *et al.* '119 is overcome. Reconsideration and withdrawal are respectfully requested.

Furthermore, Applicants realize that the present rejection is under 35 U.S.C. § 102(b). In the event that the Examiner withdraws this rejection but considers patentability under 35 U.S.C. § 103(a), Applicants submit the following supplemental remarks.

First, *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), has provided the controlling framework for an obviousness analysis, wherein a proper analysis under § 103(a) requires consideration of the four *Graham* factors. One such factor includes the evaluation of any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. at 17, 148 USPQ at 467.

Second, Applicants note that the present invention has achieved unexpected results. As described in the Examples of Applicants' specification, when the mixing ratio (weight ratio) of maltitol to cane sugar is 15:85 to 60:40, the present invention achieves an unexpected, excellent flavor improving effect. The tested Examples (of food and drinks) show the quality of flavor has a higher evaluation than when the mixing ratio is 100:0 or 0:100. In other words, it is clear that the food of the present invention has a flavor improving effect.

In contrast to the present invention, the cited Bruke *et al.* '119 reference merely discloses that isomaltulose is used in place of all or part of the saccharose as described above and is silent regarding the instantly claimed maltitol.

On the other hand, the present invention provides a special effect in that flavor is greatly improved by mixing maltitol and cane sugar in a specific weight ratio. Consequently, the present invention is not the invention disclosed in the cited Bruke *et al.* '119 reference and the features and advantages of the present invention are not even attained based upon a reading of the Bruke *et al.* reference.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By

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Attachment: Abstract